

**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed November 14, 2003 (the "Office Action"). The Examiner rejects Claims 1-20 and 22 and objects to Claims 21 and 23. Applicants amend Claims 6-7 and 14-15 to correct typographical spelling errors. Applicants respectfully request reconsideration and favorable action in this case.

**Consideration of Information Disclosure Statements**

Applicants filed Information Disclosure Statements on October 20, 2000, November 17, 2000 and March 14, 2002 (the "IDSs"). The Examiner failed to initial a foreign patent document WO 95/26600 on the PTO Form 1449 filed with the IDS filed October 20, 2000. The Examiner failed to initial all the U.S. Patents listed on page 1 and also a non-patent reference "Photography of Northern Telecom Card" on page 2 of the PTO Form 1449 filed with the IDS filed November 17, 2000. The Examiner failed to initial the first two non-patent documents on page 2 of the PTO Form 1449 filed with the IDS filed March 14, 2002. Applicants respectfully request the Examiner to consider all of the art cited in the IDSs filed October 20, 2000, November 17, 2000 and March 14, 2002, and in the event a patent issues on this Application, that this art be printed on the face of the issued patent. Furthermore, Applicants respectfully request copies of the above-identified PTO Forms 1449 indicating consideration of these references.

**Section 103 Rejections**

The Office Action rejects Claims 1, 3-4, 6, 10, 14, 18-19 and 22 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 6,470,018 B1 to Wiley et al ("*Wiley*") in view of U.S. Patent No. 6,041,055 to Chopping ("*Chopping*"). The Office Action rejects Claims 7-9 and 15-17 under 35 U.S.C. § 103 (a) as being unpatentable over *Wiley* in view of *Chopping*, and further in view of U.S. Patent No. 5,187,706 to Frankel et al. ("*Frankel*"), and further in view of U.S. Patent No. 5,159,595 to Flanagan et al. ("*Flanagan*"). The Office Action rejects Claims 2, 5 and 11-13 under 35 U.S.C. § 103 (a) as being unpatentable over *Wiley* in view of *Chopping*, and further in view of *Flanagan*. The Office Action rejects Claim 20 under 35 U.S.C. § 103 (a) as being unpatentable over *Wiley* in view of *Chopping*,

and further in view of *Frankel*. Applicants respectfully traverse each of these rejections for the reasons discussed below.

In order to establish a prima facie case of obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *See In re Royka*, 409 F.2d 981 (CCPA 1974). Applicants respectfully submit that the cited references used in the rejection do not disclose, teach or suggest all the elements of Claims 1-20 and 22.

Claims 1, 10 and 18 each recites a primary rate switch fabric operable to switch the first plurality of transport signals at a first level and a sub-rate switching fabric operable to switch the second plurality of transport signals at second level that is a more granular level than the first level. The Office Action suggests that interface 506 of Figure 5 of *Wiley* is a primary switching fabric and interface 510 of Figure 5 of *Wiley* is a sub-rate switching fabric. *See* Office Action, page 2. Applicants respectfully disagree. Interface 506 is an OCN/STS-N interface that can accept OC-N formatted calls and STS-N formatted calls and convert the calls to the DS3 format. *See Wiley*, col. 18, lines 62-64. Interface 510 accepts calls in the DS1 format and converts the calls to the DS0 format. *See id.*, col. 19, lines 1-2. Thus, interfaces 506 and 510 merely accept calls in one format and convert them to another format. However, interfaces 506 and 510 are not switch fabric operable to switch pluralities of transport signals at particular levels. Moreover, *Wiley* does not disclose, teach or suggest these elements. *Wiley* merely discloses connecting calls in a broadband system using the ATM protocol for switching. *See Wiley*, Abstract. *Wiley* does not disclose, teach or suggest a primary rate switch fabric operable to switch the first plurality of transport signals at a first level and a sub-rate switching fabric operable to switch the second plurality of transport signals at second level that is a more granular level than the first level. Thus, for at least these reasons, Applicants respectfully submit that Claims 1, 10 and 18 are patentable over the cited art used in the rejections and request that the rejections of Claims 1, 10 and 18 be withdrawn.

Claims 2-9 and 11-17 each depends, either directly or indirectly, from at least one of Claims 1 and 10. Thus, for the reasons stated above with respect to Claims 1 and 10,

Applicants respectfully submit that Claims 2-9 and 11-17 are patentable over the cited art used in the rejections and request allowance of Claims 2-9 and 11-17.

Claim 19 recites performing primary rate switching on a first transport signal comprising pass-through traffic requiring primary rate switching and performing sub-rate switching on a second transport signal comprising sub-rate traffic requiring sub-rate switching. As discussed above with respect to Claims 1, 10 and 18, *Wiley* does not disclose, teach or suggest performing primary rate switching on traffic requiring primary rate switching and performing sub-rate switching on traffic requiring sub-rate switching. Thus, for at least these reasons, Applicants respectfully submit that Claim 19 is patentable over the cited art used in the rejection and request that the rejection of Claim 19 be withdrawn.

Claims 20 and 22 each depends from Claim 19. Thus, for the reasons stated above with respect to Claim 19, Applicants respectfully submit that Claims 20 and 22 are patentable over the cited art used in the rejection and request allowance of Claims 20 and 22.

Moreover, the Office Action states that *Wiley* "does not disclose TDM signal is more granular than the first signal level" but that *Chopping* "discloses, in Fig. 1, a switching fabric comprising two switches of different granularities, one is more granularity than the other." See Office Action, pages 1 and 2. The Office Action states "[t]herefore, it would have been obvious to one skill in the art to use the **Chopping**'s method in order to apply the difference in granularity of switches with **Wiley et al.** so that TDM signals can be switched at a more granularity level than STS-1 level." See *id.*, page 2 (emphasis in original). The Office Action makes other general "it would have been obvious" statements with respect to rejections of other claims. See, e.g., Office Action, page 4 (rejection of Claims 7 and 15), page 5 (rejection of Claims 2, 5 and 13 and rejection of Claims 11 and 12) and page 6 (rejection of Claim 20).

The MPEP sets forth a strict legal standard for finding obviousness based on a combination of references. According to the MPEP, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art" at the time of the invention. MPEP 2143.01. The "fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination" or modification. *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear.<sup>1</sup> According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).<sup>2</sup> In the present case, the Examiner is

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<sup>1</sup> Note MPEP 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

<sup>2</sup> See also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the

improperly using the Applicants' disclosure as a blueprint for piecing together various elements of *Wiley*, *Chopping*, *Frankel* and *Flanagan*. Furthermore, the Examiner has merely stated that at the time the present invention was made, it would have been obvious for one of ordinary skill in the art to combine the teachings of two or more of *Wiley*, *Chopping*, *Frankel* and *Flanagan*. However, even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed combination is not sufficient to establish obviousness. *See In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

Consequently, a *prima facie* case of obviousness cannot be maintained with respect to Claims 1-20 and 22, as the Office Action has not show the requisite proof necessary to establish a suggestion or motivation to combine the cited references. Therefore, for at least this additional reason, Applicants respectfully request that the rejections of Claims 1-20 and 22 be withdrawn.

**Allowable Subject Matter**

Applicants appreciate Examiner's indication that Claims 21 and 23 would be allowable if rewritten in independent form, including all the elements of the base claim and any intervening claims. Applicants respectfully submit that Claims 21 and 23 are allowable as depending from allowable Claims 20 and 22, respectively.

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herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.).

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**CONCLUSIONS**

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicants hereby request a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,  
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